

REMARKS

The Applicant has filed the present Response in reply to the outstanding Official Action of October 27, 2004, and the Applicant believes the Response to be fully responsive to the Official Action for reasons set forth below in greater detail.

In the Official Action, the Examiner maintained the rejection of Claims 1-10 pursuant to 35 U.S.C. 103(a), as allegedly unpatentable over Abe Yuko (Japanese Patent Application No. 8-275216), which was cited in an Information Disclosure Statement for the above-identified U.S. patent application. Additionally, the Examiner rejected the claims as being unpatentable over Yuko in view of Motegi U.S. Patent No. 5,304,986.

More specifically, the Examiner alleged that Yuko's automatic stop means and the release of the automatic stop means for emergent messages teaches or suggests the combination of automatically stopping sound generation and switching to another alert operation, and continuous sound generation, as particularly claimed in Claims 1 and 10. Additionally, as stated in the prior office action, the Examiner asserts that the receiver in Abe appears to have analogously a first and second table used to determine whether an urgent sound or automatically stopped sound should be made. According to the Examiner, the device has setting information as to which caller/message the device should respond to, and the sound generation should be automatically stopped or be continuous depending on whether the call is determined to be urgent.

Applicant respectfully disagrees with the Examiner's rejection of the claims and traverses the rejection with at least the following analysis.

Applicant would first like to note that the claims have been amended herewith for clarification purposes. Of particular note, Claim 1 has been amended to specify an alert section for conducting an alert operation notifying a reception of a message in response to an alert instruction. Furthermore, the claim has been amended to recite, *inter alia*, that the first table is for previously storing setting information regarding every ID number in which a condition whether the alert operation should be automatically stopped after a predetermined period from the reception of the message or not and another condition to stop automatically the alert operation are set; the second table is for previously storing a second setting information in which a condition of sound generation is set when the alert operation should be continuously conducted. Amended Claim 1 further recites, *inter alia*, a control section for reading out the first setting information corresponding to the ID number on the basis of the ID number contained in a received radio signal, with reference to the first table, determining whether the alert operation should be stopped, and sending the alert instruction to the alert section on the basis of the first setting information when the matter is such that the alert operation should be automatically stopped, and sending the alert instruction to the alert section on the basis of the second setting information when the matter is such that the alert operation should not be automatically stopped.

Claim 10 has been amended to recite the corresponding method steps.

Claims 2, 3, 5 and 8 have also been amended for clarification of the claimed invention. For example, Claim 8 has been amended to recite, *inter alia*, an external switch in which the control section sends the alert instruction to the alert section in response to the operation of the external switch.

No new matter has been added by the aforementioned amendments. Applicant invites the Examiner to review pages 5-8, page 11, lines 3-6, 21-23, page 13, and pages 15-16 of the specification for support.

The Applicant respectfully disagrees with the Examiner's allegations and as a consequence proffers the following arguments to patentably distinguish the claimed invention, as original claimed and claimed in the amended claims, from the prior art references pursuant to 35 U.S.C. §103(a).

Insofar as rejections pursuant to 35 U.S.C. §103(a) are concerned, the Federal Circuit in In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992) has annunciated that “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification” (emphasis added). Furthermore, the annunciated principle requires that the prior art suggest modifying the teachings of the references so as to produce the claimed invention. Id. At the time the invention is made, there must be reason apparent to a skilled artisan for applying the teachings of the reference or else the use of such teachings will be improper hindsight. In re Noyima, 184 USPQ 607 (C.C.P.A. 1975).

Additionally, the Examiner cannot establish obviousness by locating references which describe various aspects of an invention without also providing evidence of the motivating force which would impel the skilled artisan to do what the applicant has done. Ex Parte Levengood, 28 USPQ 2d 1330, 1302 (Bd. Pt. App. & Int'l. 1993).

The primary prior art reference to Yuko is directed to a pocket beeper 1 having a kidnapping prevention function. Specifically, Yuko teaches an automatic stop means for stopping the generation of an alarm tone automatically for the “non-emergent” messages received by the pocket beeper 1. The kinds of alarm tones correspond to predetermined messages. Additionally, Yuko teaches releasing the automatic stop means for continuously generating an emergent alarm tone and displaying an emergent mark on display means 2 for the “emergent” messages received by the pocket beeper 1.

Applicant respectfully submits that primary prior art reference to Yuko is defective in that it fails to teach or suggest (i) teach a first and second table as claimed, (ii) control section for generating an alert instruction determined based upon setting information of both tables, (iii) setting information as claimed and defined in the specification; (iv) automatically stopping sound generation and switching to another alert operation; (v) determining the alert operation prior to discriminating the message.

First, the reference fails to teach a first and second table as claimed. The examiner incorrectly asserts that this feature is inherent in the reference. At best, the reference teaches controlling the sound based on the type of message, wherein a predetermined

control instruction is stored in memory. This however, does not teach a first and second table as specifically claimed.

Second, since the reference fails to teach a first and second table, the reference also fails to teach a control section for generating an alert instruction determined based upon setting information of both tables.

Third, the setting information as claimed and defined in the specification is different. Specifically, the setting information included in the first table includes address ID information, A/R information, vibration driver information and sound generation information. The A/R information is an automatic stop/continuous control signal. When the A/R information is set at IN, the control section generates a melody signal, a volume signal, a beep signal and a vibration signal as alert instructions. When the A/R information is set at OFF, the control section looks up information from the second table.

Fourth, the reference fails to teach automatically stopping sound generation and switching to another alert operation as particularly recited by the claims.

In the outstanding official action, the Examiner responded to this alleged difference by stating that, when an emergency message is received and recognized by the receiver, the automatic stop means is released, and the emergency tone is generated continuously, and thus it is inherent that after a non-emergency message is stopped if an emergency message is received, the emergency tone will be generated.

It appears that the prior art reference is concerned with the difference between non-emergency and emergency messages. Whereas in stark contrast, the claimed invention appears to be concerned with recognizing and alerting a user, using different alarm tones, of different types of emergency messages. For example, Figure 7A shows the alert operation executing on the basis of the first table, and Figure 7b shows the alert operation executing on the basis of the second table. Both messages appear to be an “emergency” or an important message, however, the different is that the user would be able to grasp the degree of emergency of the call based upon the type of the auditory tone. The user will discriminate the sound pattern based upon the tones generated by the first and second table to hear the degree of the emergency of the call.

Lastly, the present invention does not discriminate the message prior to determining the notifying operation. Specifically, in the claimed invention, upon receiving a message, a first table is looked up on the basis of the ID number contained in the received message and a first setting information be read out based upon an ID number match, and the content of the notifying operation is determined by the first setting means. Yuko, in stark contrast discloses a selective calling receiver, which has an operative feature such that it first discriminated whether the message contains a normal message or an urgent emergency message and subsequently determines what the notifying operation should be.

In operation, Yuko controls the type of tone based upon the *type of message*, when a prescribed message is received; a tone of a kind corresponding to the message is generated. Whereas in contrast, the control section compares an **acquired ID number with each of the ID numbers stored in the ID memory section**. When it is determined by comparison that the acquired number coincides with one of the ID numbers stored in the ID memory section, the control section looks up the first table alert data setting information.

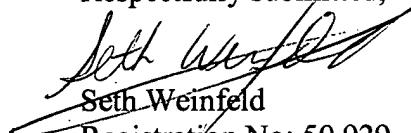
Motegi does not remove any of the above noted deficiencies. Therefore, the hypothetically combined Yuko-Motegi system fails to teach, suggest or render obvious each and every limitation of independent Claims 1 and 10. Dependent Claims 2-9 are patentably distinct from the cited references for at least the same reasoning as stated above.

Accordingly, we believe that the all of the claims of the instant application are patentably distinct from the cited reference.

For all the foregoing reasons, the Applicant respectfully requests the Examiner to withdraw the rejections of independent Claims 1 and 10 pursuant to 35 U.S.C. § 103(a). Furthermore, the Applicant respectfully requests the Examiner to withdraw rejections of dependent Claims 2-4 and 6-9 based at least on their respective dependencies, whether direct or indirect, from independent Claim 1. Applicant further submits that Claim 5 is patentably distinct from the cited references.

In conclusion, the Applicant believes that the above-identified application is in condition for allowance and henceforth respectfully solicits the Examiner to allow the application. If the Examiner believes a telephone conference might expedite the allowance of this application, the Applicant respectfully requests that the Examiner call the undersigned, Applicant's attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,



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